30 April 2012

From: Mark D. Estes, Austin, TX estesmd@gmail.com
RE: USPTO RFQ -- Docket No.: PTO-P-2012-0012

To Whom it may Concern:

Any advantage derived from the screening of patent applications to protect economically significant patents from discovery by foreign entities:

1. is inherently non-quantifiable with regard to perceived foreign interlopers, yet

2. would become inherently costly in measurable terms, domestically!

Martindale reported favorable outcomes in the first phase of the Peer to Patent experiment:

The Peer-to-Patent program began as an experiment aimed at improving the quality of issued patents by allowing U.S. patent examiners to access prior art submitted by the general public via open network peer review of patent applications. Participation was voluntary, and the program was initially limited to applications in Group 2100 (computer hardware/software), but subsequently expanded to business methods in class 705.

The USPTO reported that 66 Office Actions were issued for applications that underwent peer review, and prior art submitted through the program was utilized by examiners in 18 of those applications. In addition, between 12-21% of examiners reported that prior art obtained through the program was otherwise inaccessible by the USPTO.

The proposed "benefits" of the USPTO Peer Review Pilot FY2011 would become a casualty if the secret process is arbitrarily extended:

- The application will be advanced out of turn for examination and reviewed earlier (accorded special status similar to applications in the Green Technology Pilot Program);

- No petition fee is required;

- Having the published application posted on the Peer To Patent Web site, volunteer scientific and technical experts will be able to discuss the application and submit prior art through Peer To Patent, thereby contributing to the quality of any patent resulting from the published application.

- Additional relevant prior art references may be made of record and considered by the examiner at an early stage of examination; and

- The prior art references cited under the pilot will be printed on any patent issuing from the application that participated in the pilot program.

From the 1st anniversary report of the Peer to Patent program:

The success of Peer-to-Patent has not gone unnoticed. Many other national patent offices suffer from the same problems as the USPTO, namely, a significant backlog of applications, lack of time for examination, deficiency in personnel, and gaps in the accessibility of information. These agencies also understand the need for taking action.

From the 2nd anniversary report:

[Eliminating] the need for consent of the applicant and ultimately, [will] lead to more thoroughly reviewed applications and more meritorious patents through the benefits of third-party reviewers, already illustrated by the success of Peer-to-Patent.

Others note that "designing around" a competitor is not the only reason for monitoring a competitor's IP:

... based on information gleaned from the patent application, a design around or improvement upon the competitor's technology may be developed. Alternatively, such a review may help your business decide to shift a in a different direction, especially where designing around the competitor's technology will be difficult or if the competitor appears to have a strong technical advantage. ...reviewing published applications can provide early warning signs regarding intellectual property issues that may arise in the future. For this reason, monitoring can be especially important to provide an early warning of a potential problem if your competitors are litigious. An early warning can allow you to get a head start on formulating a response.

The prior art problem would only be made worse if the secret process proposal goes forward. In a loosely-related issue regarding fair use of prior art submissions, a policy watchdog asked :

Isn't one of the biggest problems we have with patents today the ... lack of prior art on submissions? Isn't it in everyone's best interest to use the available sci/tech literature to make the best possible prior art decisions?

More specifically, the prohibition of foreign filing (page 7) and the limited disclosure provision (page 9) make the proposal economically untenable.

1. An applicant making such a request must certify that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or filed under a multilateral international agreement that requires publication of applications 18 months after filing.

2. This new procedure would institute a secrecy order that forbids applicants from disclosing subject matter deemed to be detrimental to national economic security for such period as the national interest requires. This restrictions would most likely be lobbied against by the very same proponents of the first proposal, and, thus, be lifted soon after its adoption!

My response to Q1:

The USPTO SHOULD NOT institute a plan to identify patent applications relating to critical technologies or technologies important to the United States economy to be placed under secrecy orders.